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LAW OFFICES OF JONATHAN ALAN QUINE

By: \_\_\_\_\_

Chianti Appling

Atty Docket No: 300-903820US

Election/Ext(4)/#23

4.30.02

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

**AKIRA KOMORIYA and BEVERLY  
PACKARD**

Application No.: 09/394,019

Filed: 09/10/1999

For: **COMPOSITIONS FOR THE  
DETECTION OF ENZYME ACTIVITY IN  
BIOLOGICAL SAMPLES AND METHODS  
OF USE THEREOF**



Examiner: Chih Min Kam

Art Unit: 1653

**RESPONSE TO RESTRICTION  
REQUIREMENT**

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Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This paper is filed in response to the Office Action dated November 21, 2001 containing a Restriction Requirement. The following documents are enclosed herewith:

- 1) A petition to extend the period of response for four months.

**REMARKS**

In the November 21, 2001 Office Action the Examiner required restriction to one of the following groups under 35 U.S.C. §121:

- Group I: Claims 1-15, drawn to a fluorogenic composition for the detection of the activity of a protease; and
- Group II: Claims 16-26, drawn to a method of detecting the activity of a protease;

**In response to this restriction requirement, Applicants provisionally elect Group I, claims 1-15, with traverse.**

Applicants submit that restriction between Groups I and II is unnecessary. According to MPEP §803, the Examiner should examine all claims in an application, **even though they are directed to distinct inventions**, unless to do so would create a serious burden. In the instant case, the claims of Group I are directed particular fluorogenic protease indicators, while the claims of

Group II are directed to methods using those same fluorogenic protease indicators. A search for prior art relevant to the compositions claimed in Group I is expect to identify any prior art, if such exists, relevant to the use of those same compositions. Accordingly, a search and examination of Groups I and II together requires no greater burden than a search and examination of Group I, alone. A search and examination of Groups I and II, together, therefore does not create a "serious burden".

Accordingly, in light of M.P.E.P. §803, the restriction between Groups I and II should be withdrawn.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 337-7871.

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Respectfully submitted,



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